UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,747	10/24/2001	Igor Davidovich Kushnirskiy	0007056-0214/P6299	2713

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SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER
KANG, INSUN

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Applicati n No.	Applicant(s) -
Office Action Summary	10/001,747	KUSHNIRSKIY, IGOR DAVIDOVICH
	Examiner	Art Unit
	Insun Kang	2124

-- The MAILING DATE of this communication appears on th cover she t with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2001*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-39* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *24 October 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some * c)☐ None of:
         1.☐ Certified copies of the priority documents have been received.
         2.☐ Certified copies of the priority documents have been received in Application No. _____.
         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
            application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: 37 CFR 1.105 product information request form .

DETAILED ACTION

1. This action is responding to application paper dated 10/24/2001.

2. Claims 1-39 are pending in the application.

Drawings

3.   Figures 1, 2, and 8 should be designated by a legend such as --Prior Art--
because only that which is old is illustrated. See MPEP § 608.02(g). Corrected
drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action
to avoid abandonment of the application. The replacement sheet(s) should be labeled
"Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct
any portion of the drawing figures. If the changes are not accepted by the examiner, the
applicant will be notified and informed of any required corrective action in the next Office
action. The objection to the drawings will not be held in abeyance.

Specification

4.   The abstract of the disclosure is objected to because:

Applicant is reminded of the proper language and format for an abstract of the
disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on
a separate sheet within the range of 50 to 150 words. It is important that the abstract
not exceed 150 words in length since the space provided for the abstract on the
computer tape used by the printer is limited. The form and legal phraseology often used
in patent claims, such as "means" and "said," should be avoided. The abstract should
describe the disclosure sufficiently to assist readers in deciding whether there is a need
for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in
the title. It should avoid using phrases which can be implied, such as, "The disclosure
concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract uses a phrase, which can be implied such as "Embodiments of the present invention relate" etc. Correction is required. See MPEP § 608.01(b).

5.   The use of the trademark JAVA has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.   Claims 1-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-13 are non-statutory because they are directed to a "method" merely reciting a "method for developing a plug-in" including the steps of incorporating an API in said plug-in, using the API, and integrating the plug-in into the host application. The claims do not recite a description of what the plug-in developing actually was or how the steps such as incorporating etc were conducted with respect to developing the plug-in. Causing an action or an intended action is different from actually performing an action. Incorporating an API in the plug-in "for" developing the plug-in does not necessarily mean that the developing step is actually performed. Therefore, the method for developing a plug-in is only an intended action. Thus the claims represent non-

functional descriptive material that is not capable of producing a useful result, and

hence represent only abstract ideas. Therefore, the claims are non-statutory.

Claims 14-26 are non-statutory because they are directed to a "computer

program product" merely comprising a "computer usable medium having computer

readable program code" that are "configured to cause a computer to" do the claimed

steps. Causing an action or an intended action is different from actually performing the

action. "Causing" only requires serving as the reason for an action, not necessarily

performing the action. Therefore, the action by the computer readable code (configured

to cause a computer to perform the claimed functions) is only an intended action. Thus

the claims represent non-functional descriptive material that is not capable of producing

a useful result, and hence represent only abstract ideas. Therefore, the claims are non-

statutory.

Claims 27-39 are non-statutory because they are directed to an "apparatus"

comprising an API and a functional module which are mere computer programs and

they are configured to be incorporated and created (not in action yet). Therefore, the

apparatus is considered to be disembodied arrangement so as to be called a "computer

program" or compilation of facts, information, or data per se, without creating any

functional interrelationship, either as part of the stored data or as part of the computing

processes performed by the computer ("acts") or computer readable medium so as to

enable the computer to perform the claimed elements' functionalities as recited. Thus

the claims represent non-functional descriptive material that is not capable of producing

a useful result, and hence represent only abstract ideas. Therefore, the claims are non-

statutory.

Claim Objections

8.   Claim 39 is objected to because of the following informalities: there appears to

be an error in claim 39: "The method" needs to be corrected to "The apparatus."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

10.   Claims 1-39 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Per claims 1, 14, and 27, the claims recite, "integrating said plug-in." It is unclear as

to what plug-in it is referring in the claims. The preamble recites, "method for

developing a plug-in." It means incorporating an API in the developed plug-in? If so, it

appears that the method comprising the claimed steps is not directed "for developing a

plug-in." It is unclear how the functional module is related to the plug-in.

Per claims 2, 15, and 28, the claims recite, "said API allows said host ...to launch

executables." It is unclear whether the host application actually performs the action,

launching the executables. It is noted that "allowing something" is distinct from actually

doing the action, such as launching.

Per claims 11, 24, and 37, the claims recite, "said pluglet engine API allows said host ...to access a ...JVM." It is unclear whether the host application and said pluglet API actually access the JVM or they are allowed to access but are not actually doing the action, accessing. It is noted that "allowing something" is distinct from actually doing the action.

Per claims 12, 25, and 38, the claims recite, "said pluglet stream information interface allowing said plug-in to access information." It is unclear whether the plug-in actually access the information or it is allowed to access but is not actually doing the action, accessing. It is noted that "allowing something" is distinct from actually doing the action.

Claims 3, 5, 7 16, 18, 20, 29, 31, and 33 contain the trademark/trade name JAVA and JAVABEAN Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a JAVA and, accordingly, the identification/description is indefinite.

As per claims 4, 6, 8-10, 13, 17, 19, 21, 22, 23, 26, 30, 32, 34-36, and 39, these

claims are rejected for dependency on the above rejected parent claims.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12.   Claims 1-3, 8, 9, 13-16, 21, 22, 2-29, 34, 35, and 39 are rejected under 35

U.S.C. 102(b) as being anticipated by Applicant's Admitted Prior Art (hereinafter

referred to as "APA") disclosed in the instant application.

Per claim 1:

APA discloses:

- incorporating an API in said plug-in, wherein said API enables said plug-in to be

   executed from a host application and data to be transmitted between said plug-in

   and said host application ("each implementation of a web browser on the same

   platform has its own unique plug-in programming interfaces... in plug-in

   development the term "platform" is extended to include details specific to both the

   browser and the operating system in which the browser is implemented," page 5

   lines 4-9)

- using said API to create a functional module wherein said functional module

  extends functionality of said host application ("plug-ins are software modules that

  extend the functionality of a web browser. A common use of plug-ins is to extend

  the browser support for specialized content such as animation...plug-ins provide

  a mechanism for content makers to create software modules that enable

  browsers to display the specialized content," page 1 lines 3-15)

- integrating said plug-in into said host application (plug-ins provide a mechanism

  for content makers to create software modules that enable browsers to display

  the specialized content," page 1 lines 3-15) as claimed.

Per claim 2:

The rejection of claim 1 is incorporated, and further, APA teaches:

- said functional module is an executable launcher wherein said API allows said

  host application to launch executables via said executable launcher ("Currently

  there exist plug-ins that enable web browsers to launch Java Applets or

  JaveBeans™ components with the most updated Java Runtime Environment

  (JRE). These plug-ins are called java Plug-ins," page 6 lines 2-4; page 1, lines

  11-15) as claimed.

Per claim 3:

The rejection of claim 2 is incorporated, and further, APA teaches:

- said executables are Java applets and JavaBean components ("Currently there

  exist plug-ins that enable web browsers to launch Java Applets or JaveBeans™

  components with the most updated Java Runtime Environment (JRE). These

plug-ins are called java Plug-ins," page 6 lines 2-4; page 1, lines 11-15) as

claimed.

Per claim 8:

The rejection of claim 1 is incorporated, and further, APA teaches:

- said data further comprises an applet location, an applet identification information

    and an input data stream ("Currently there exist plug-ins that enable web

    browsers to launch Java Applets or JaveBeans™ components with the most

    updated Java Runtime Environment (JRE). These plug-ins are called java Plug-

    ins," page 6 lines 2-4; "when a browser application executing on client platform

    102 requests an HTML document ...to web server 108, the browser automatically

    initiates the download of the class files 107 identified in the HTML document,"

    page 4 lines 9-15) as claimed.

Per claim 9:

The rejection of claim 1 is incorporated, and further, APA teaches:

- said host application is a web browser ("plug-ins are software modules that

    extend the functionality of a web browser," page 1 lines 3-15) as claimed.

Per claim 13:

The rejection of claim 1 is incorporated, and further, APA teaches:

- said integrating further comprises writing a manifest file for said plug-in

    ("Currently there exist plug-ins that enable web browsers to launch Java Applets

    or JaveBeans™ components with the most updated Java Runtime Environment

    (JRE). These plug-ins are called java Plug-ins," page 6 lines 2-4) as claimed.

Per claims 14-16, 21, 22, and 26, they are the product versions of claims 1-3, 8, 9,

and 13, respectively, and are rejected for the same reasons set forth in connection with

the rejection of claims 1-3, 8, 9, and 13 above.

Per claims 27-29, 34, 35, and 39, they are the apparatus versions of claims 1-3, 8, 9,

and 13, respectively, and are rejected for the same reasons set forth in connection with

the rejection of claims 1-3, 8, 9, and 13 above.

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

14.   Claims 4-7, 10-12, 17-20, 23-25, 30-33, and 36-38 are rejected under 35

U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter

referred to as "APA") disclosed in the instant application as applied to claim 1-3, 8, 9,

13-16, 21, 22, 2-29, 34, 35, and 39 above, in view of Mozilla organization ("Pluglet

Developers Guide pluglet Overview," 1998-2/2001) hereinafter referred to as "Mozilla."

Per claim 5:

APA does not explicitly teach that said platform independent programming language is
Java. However, Mozzila teaches a plug-in written in Java (pluglet) was well known in
the art of software component-based and browser plug-in development, at the time
applicant's invention was made, to develop a browser plug-in for portability across
different browsers ("A Pluglet is a Mozilla Plugin written in Java using the Pluglet API,"
Mozilla, page 1 second paragraph) such as those disclosed in Mozilla. It would have
been obvious for one having ordinary skill in the art of software component-based and
browser plug-in development to modify APA's disclosed plug-in to be written in Java.
The modification would be obvious because one having ordinary skill in the art would be
motivated to achieve code reuse avoiding version inconsistency problem as suggested
by Mozzila (page 1, Pluglet Definition and How Pluglets work).

Per claim 4, this claim is the broader version of the claimed method discussed in
claim 5, wherein all claim limitations also have been addressed and/or covered in cited
areas as set forth the above.

Per claim 7,

APA does not explicitly teach that said platform independent programming language is
Java. However, Mozzila clearly teaches a plug-in written in Java (pluglet) was well
known in the art of software component-based and browser plug-in development, at the
time applicant's invention was made, to develop a browser plug-in for portability across
different browsers ("A Pluglet is a Mozilla Plugin written in Java using the Pluglet API,"

Mozilla, page 1 second paragraph) such as those disclosed in Mozilla. It would have
been obvious for one having ordinary skill in the art of software component-based and
browser plug-in development to modify APA's disclosed plug-in to be written in Java.
The modification would be obvious because one having ordinary skill in the art would be
motivated to achieve code reuse avoiding version inconsistency problem as suggested
by Mozzila (page 1, Pluglet Definition and How Pluglets work).

Per claim 6, this claim is the broader version of the claimed method discussed in claim
7, wherein all claim limitations also have been addressed and/or covered in cited areas
as set forth the above.

Per claim 10:
The rejection of claim 1 is incorporated, and further, APA does not explicitly teach that
said API is a pluglet API.   However, Mozzila clearly teaches a Pluglet API was well
known in the art of software component-based and browser plug-in development, at-the
time applicant's invention was made, to develop a browser plug-in for portability across
different browsers ("A Pluglet is a Mozilla Plugin written in Java using the Pluglet API,"
Mozilla, page 1 second paragraph) such as those disclosed in Mozilla. It would have
been obvious for one having ordinary skill in the art of software component-based and
browser plug-in development to modify APA's disclosed plug-in API to be written in
Java. The modification would be obvious because one having ordinary skill in the art
would be motivated to achieve code reuse avoiding version inconsistency problem as

suggested by Mozzila (page 1, Pluglet Definition and How Pluglets work). Mozzila further discloses the three main types of Pluglet interfaces: 1) a pluglet factory interface wherein an instance of said plug-in can be instantiated by said host application ("PlugletFactory knows the name of the Pluglet class to load," page 2 third paragraph; see also PlugletFactory Interface index for details) 2) a pluglet interface defining the requirements for a plug-in implementation ("the browser creates an instance of PlugletFactory and uses that to create an instance of Pluglet for the MIME type," page 2 third paragraph; see also index for details) 3) a pluglet stream listener interface enabling data transfer between said plug-in and said host application ("creating an instance of PlugletStreamListener, which is used for notification and passing of information about the stream," page 2 paragraphs 4-5; see also PlugletStreamListener Interface index for details).

Per claim 11:

The rejection of claim 10 is incorporated, and further, Mozilla teaches that said pluglet API uses a pluglet engine API to communicate with said host application and wherein said pluglet engine API allows said host application and said pluglet API to access a Java Virtual Machine (JVM) ("When a MIME type is first encountered by the Mozila browser, it checks to see that there is a native plugin for it. If there is not, it looks for a Pluglet that handles the MIME type. It does this through PlugletEngine," page 1, How Pluglets Work) as claimed.

Per claim 12:

The rejection of claim 11 is incorporated, and further, Mozilla clearly teaches that said

pluglet engine API further comprises:

- a pluglet manager interface enabling information be passed between said host

  application and said plug-in ("The PlugletManager interface includes functionality

  to get and post URLs and return userAgent for the browser, see the API index for

  PlugletManager interface)

- a pluglet peer interface defining compatibility requirements for host applications

  to run said plug-in (see the API index for PlugletPeer interface)

- a pluglet tag information interface wherein HTML tag information for said plug-in

  is provided (see the API index for PlugletTagInfo interface)

- a pluglet stream information interface allowing said plug-in to access information

  on data streams sent to said plug-in (see the API index for PlugletStreamInfo

  interface for details) as claimed.

Per claims 17-20 and 23-25, they are the product versions of claims 4-7 and 10-

12, respectively, and are rejected for the same reasons set forth in connection with the

rejection of claims 4-7 and 10-12 above.

Per claims 30-33 and 36-38, they are the apparatus versions of claims 4-7 and

10-12, respectively, and are rejected for the same reasons set forth in connection with

the rejection of claims 4-7 and 10-12 above.

15.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Insun Kang whose telephone number is 571-272-3724.

The examiner can normally be reached on M-F 9:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on 571-272-3719. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

I. Kang
Patent Examiner
12/1/2004

1.   An issue of public use or on sale activity has been raised in this application. In
order for the examiner to properly consider patentability of the claimed invention under
35 U.S.C. 102(b), Applicant and the assignee of this application are required under 37
CFR 1.105 to provide the following information that the examiner had determined is
reasonably necessary to the examination of this application.

2.   The information on the latest version of Pluglet released prior to 10/24/2000 is
required to identify products and services embodying the disclosed subject matter of
claims 5, 7, 8, 12, 13, 16, 20, 18, 21, 25, 26, 29, 33, 31, 34, 38, 39.

2.1) Please state whether the Pluglet and executable launcher in claims 5 and 7 are
written in Java in the released version(s).

2.2) Please state whether the subject matters in claims 8, 21, and 34 are included in the
released version(s).

2.3) Please state whether the subject matter disclosed in claims 12, 25, and 38 are
included in the released version(s).

2.4) Please state whether the subject matters in claims 13, 26, and 39 are included in
the released version(s).

3.   The fee and certification requirements of 37 CFR 1.97 are waived for those
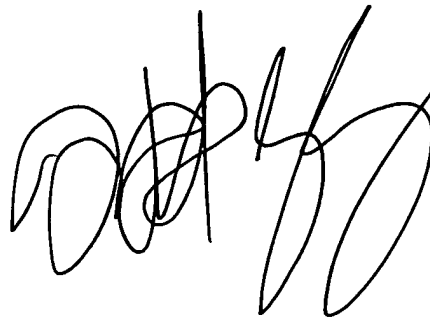documents submitted in reply to this requirement. This waiver extends only to those

documents within the scope of the requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97 where appropriate.

4.   The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

5.   This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

I. Kang
Patent Examiner
12/1/2004

TODD INGBERG
PRIMARY EXAMINER